



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,094	05/09/2001	Mark R. Dec	830063.402	5243

500 7590 11/03/2004

SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 6300
SEATTLE, WA 98104-7092

EXAMINER



RUHL, DENNIS WILLIAM

ART UNIT PAPER NUMBER

3629

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

 Office Action Summary	Application No. 09/853,094	Applicant(s) DEE, MARK R. 	
	Examiner Dennis Ruhl	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>19092001</u> . | 6) <input type="checkbox"/> Other: ____ |

Art Unit: 3629

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 22,45, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. One of skill in the art would not know how to make the claimed invention where the reference identifier is a license plate or a number, where the ticket device can communicate with the license place or the number. One of skill in the art would necessarily have to undergo undue experimentation to figure out how to have a ticket device communicate with the number (not even a real tangible thing) or a license plate (metal with numbers on it). How does applicant make the invention as claimed in claims 22,45?

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 1,24,47,48,49,50, there are numerous problems in the claims that render them indefinite.

At line 2, there is no antecedent basis for "said regulations". What regulations are being referred to here? This is not clear.

There is no antecedent basis for "said occupant" and none has previously been claimed. This should be changed to "used by an occupant" to correct the problem.

The examiner notes that at line 6, there is a period, but there are also periods elsewhere in what appears to be the independent claims. There are at least 3 periods in one claim (cl. 1) and in claim 48 there are 5 periods. A claim is to be a one sentence legal definition of the applicant's invention that is believed to be novel and that ends in a period. This is essentially the definition of a claim. For purposes of examination the examiner considers the claims to end at the first occurrence of a period, as that identifies the end of the sentence; however the examiner will attempt to address all of what appears to be claimed. The claims are considered indefinite because of the use of more than one period, which makes it unclear where the claims end.

With respect to the wireless ticket device, it has been claimed that it can communicate with "a central processing means". Isn't this supposed to be "said central processing means" because the processing means has already been claimed in the communication means language? Or is this a 2nd processing means in addition to the one that the communication means communicates with? This is not clear. The recitation of "said central processing means" is indefinite because it is not clear which one is being referred to (two appear to have been claimed).

The portion that reads "said communication interface being capable of communicating with said occupant communications device said enforcement

Art Unit: 3629

communications device" makes no sense and there is no antecedent basis for "said enforcement communications device" (should be ticket device?). Does the communication interface communicate with the occupant's device or the enforcement communication device? It is not clear what applicant is claiming.

These claims also appear to have substantial portions that repeat what has already been claimed unless there are more than one data input subsystem, more than one data output circuitry, etc.. It seems that the recitation of the processor being "connectable to a data input..." is repeated numerous times; however the use of "a" each time seems to claim that the processor is connectable to 1,2,3, maybe more data input systems, etc.. Is this simply repeating language (which needs to be corrected and only claimed once if that is the case) or is there actually more than one set of components that the processor is connectable to?

It also appears that applicant may be attempting to recite particulars of the "communications interface"; however this is not part of the claimed invention because this feature has only been claimed in the sense that the processor is *connectable* to it. Being connectable (having the capability to connect) is different from actually being connected. Is the processor being claimed as connected to a data input subsystem, communications interface, etc., or is this just being claimed in a functional sense and is not part of the scope of the claim? This is not clear.

For claims 5,28, the language "where said occupant communication means said parking location can be..." makes no sense and is indefinite. It reads poorly and needs correction.

Art Unit: 3629

For claims 15,38, there is no antecedent basis for “the said vehicle’s vehicle identification number”. None has previously been claimed. This should be changed to “can be a vehicle identification number” to correct the problem.

For claims 17,40,61, there is no antecedent basis for “all the said reference identifier data strings” and “said parking location data strings”. None has previously been claimed so it is unclear what this refers to.

For claim 19, there is no antecedent basis for “said occupant wireless issuance device”. No device by this name has previously been claimed. Is this supposed to be the occupant communications device or the enforcement ticket device?

For claims 23,46, the recitation of “said communication means used by said enforcement personnel” seems incorrect because previously it has been recited that the enforcement personnel use the wireless ticket device. Which is correct?

For claim 48, there is no antecedent basis for “said parking location accounting system”. None has previously been claimed so it is not clear what this refers to. Is this the same thing as the central processor or a part of the processor system?

For claim 68, if the reference identifier is the phone, then what is the occupant communication means? Or are both capable of being a phone? The occupant communication means can be a phone and the reference identifier would be a 2nd phone carried by the occupant? Claim 68 seems to be claiming two different elements as the same thing. This is not clear.

Art Unit: 3629

Overall, the applicant is requested to review the pending claims and make the necessary corrections to render them definite. The claims are very confusing and the examiner has examined them as they are best understood.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Zeitman (WO 98/04080).

For claims 1-6,9,17,20,23-29,32,40,43,46-49, Zeitman discloses a parking system that includes a vehicle, a parking space as shown in figure 1. The user communication means is 20 and can be a computer or a phone (mobile and landline). The central processing means is 12. The reference identifier is disclosed on page 7, lines 18-22. The geographical identifier is the parking facility ID# disclosed by Zeitman. The wireless ticket device is 31 and is used by enforcement personnel to monitor parking and issue/record tickets as needed. The central processor records time information and counts down the time as claimed. See page 6, lines 12-22. The central processor communicates with the wireless ticket device in addition to the user communication device. See page 5, lines 13-22. Zeitman operates and is capable of what has been claimed functionally.

For claims 7,30, a computer is considered to be the same as "a personal data assistant". A computer helps manage personnel data such as personnel finances.

For claims 8,31, a mobile phone is considered to be a paging device. A person can be "paged" by calling them.

For claims 10,33, the central processing means can provide all of the claimed information. It is fully capable of doing what is claimed. All of the data recited is the type of data the system of Zeitman processes or uses so the data is clearly capable of being provided as claimed.

For claims 11,14,34,37, a license plate is a reference tag displayed on the vehicle so Zeitman satisfies the claims.

For claims 12,13,15,21,35,36,38,44, the reference identifier is perfectly capable of being provided by the central processing means, have a bar code, etc.. It "can be" what is claimed because claiming that something can be A, B, or C, does not mean that it is A, B, or C.

For claims 16,24,39, see page 5, lines 3-9 and billing apparatus 30.

For claims 18,41, if one wanted to add extra time, they could use the communication means to do it as claimed. That is what it is used for by the user.

For claims 19,42,47, the system of Zeitman is fully capable of what is claimed. The communication means and the central processor communicate with each other and transfer data. The central processor also sends parking data to the ticket device, such as time information for parked vehicles. The central processor is fully capable of notifying the occupant of time about to expire as claimed. It has this ability.

For claims 22,45, reading a number, like a license plate number or VIN number is wireless as claimed.

For claims 48,49, in addition to that set forth by the examiner previously, there is no reason that an "external party" could not pay for parking. This could be the spouse of a user of the space adding extra time on behalf of the user. Since this is a system claim who does what is not relevant to what is claimed. The system does not know whom it is interacting with and does not care. The processing means inherently uses some sort of algorithm to calculate parking fees. If one hour costs \$1, and 2 hours are requested, the system will calculate $\$1 \times 2$ hours (an algorithm) for a fee of \$2. The processing means that is claimed as providing a message to the occupant about the gratuity of an external party is not claimed as being the same as the central processor, so this limitation is interpreted to be phone of an external party. The spouse of the occupant can call them up on the phone and tell them that they just put more money in the parking meter so as to avoid getting a ticket. The claim reads on this interpretation.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 50-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ouimet (WO 97/37328) in view of Zeitman (WO 98/04080).

For claims 50-69, Ouimet discloses a parking management system that includes a central processing means 16, parking meters 12, and wireless ticket issuance devices 18. Ouimet discloses that reference identifiers (smart cards with monetary funds on them) can be used by occupants of vehicles to pay for parking and allow basic customer information to be transmitted to the parking meters 12. See page 6 of Ouimet. The parking meters operate as claimed and are fully capable of being connected to the various systems as claimed. Ouimet discloses that the central processor 16 also handles electronic transactions (credit card, debit card). Because you can pay with a smart card, the system has the ability to credit an account with payment for parking as claimed. Parking information of interest (i.e. time information as claimed) can be transmitted to enforcement personnel that have the wireless ticket devices. Not disclosed is the use of an occupant communication means that can communicate with the central processing means. Zeitman discloses a parking management system that has a high level of user convenience. Zeitman discloses that the user can directly communicate with a central computer system by using their mobile telephone and can provide the information such as vehicle space and time information by using their telephone. This would allow for more user convenience when conducting the parking space use transaction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Ouimet with the ability to take user information by telephone as is disclosed by Zeitman (an occupant communication means).

With respect to various recitations that recite that the reference identifier or communication means can be A,B or C, claiming what something *can be* is not a positive recitation of what *it is*. Patentable weight is not given to what something can be, only what it is claimed as being in a positive sense.

For claims 51-55, Zeitman discloses embodiments of the claimed communication means that satisfy what is claimed. A computer is considered to be the same as "a personal data assistant". A computer helps manage personnel data such as personnel finances. A mobile phone is considered to be a paging device. A person can be "paged" by calling them.

For claim 57, the central processing means can provide all of the claimed information. It is fully capable of doing what is claimed. All of the data recited is the type of data the system of Ouimet processes or uses so the data is clearly capable of being provided as claimed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER